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THEY KNOW IT WHEN THEY SEE IT: COPYRIGHT AND AESTHETICS IN THE SECOND CIRCUIT

JAMES H. CARTER*

The Second Circuit is widely recognized as the nation's most important copyright court. Centered in the capital city of publishing and the arts, and mindful of the proud tradition of copyright scholars who have formed its treasure of precedent, the court regularly hears appeals raising issues in the forefront of copyright developments.

The Second Circuit is not shy about its historic leadership role in shaping U.S. copyright law. Indeed, judges of the court have been active in submitting testimony to Congress on copyright matters and in scholarly comment.1 But in one regard, the court has been quite modest: the expression of aesthetic judgments2 concerning the works that come before it in copyright actions. Second Circuit judges regularly note that they are not passing judgment on the literary or artistic quality of such works, but merely on other aspects as required by the Copyright Act of 1976 (the "Copyright Act" or the "Act").3 Indeed, they strive for rules of decision that

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2 Aesthetics is "a branch of philosophy dealing with the nature of beauty, art, and taste and with the creation and appreciation of beauty"; it may also mean "a particular theory or conception of beauty or art," or "a pleasing appearance or effect." WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY 61 (1983).

seem to be removed from aesthetic judgments.

The Copyright Act provides guideposts to decisions but only limited help in answering questions about specific works. The body of case law nevertheless is large enough and consistent enough to supply guidance for most types of situations that arise, and courts are mindful of the particular need to clarify the application of copyright principles through case law. But in some instances, this effort proves difficult because the distinction being drawn is closely related to what strikes the judges as “art”—a matter not easily articulated and a subject of some discomfort to the judiciary. Examples of such situations can be found in the Second Circuit’s recent cases involving at least three copyright issues: fair use, factual compilations, and utilitarian design.

Cases in these areas may require a distinction to be drawn between material that is, on the one hand, creative, artistic and expressive, the product of intellectual effort—and therefore presumptively subject to copyright protection—and material that is merely a series of statements of fact, clichés lacking in originality, expression used in some “essentially factual” way, a compilation of “diligently collected” facts, or functional industrial design. Judges can deal with these matters in either one of two ways. The first is by enunciating detailed criteria and seeking to apply them in a manner that may be seen as resting upon the judges’ own judicial aesthetics: their conceptions of what is art or, more generally, of what is creative and expressive literary work for purposes of the Copyright Act. Alternatively, judges may postulate sweeping principles that purport to be rules of decision but actually are largely impenetrable, allowing a court in effect to say, “I know it when I see it, and that’s it.”

Though they uniformly deny performing the role of literary or

Cir. 1989) (Miner, J.) (“[m]oreover, I question whether judges, rather than literary critics, should decide whether literary material is used to enliven a test or demonstrate truth”); cert. denied, 110 S. Ct. 1168 (1990); Wright v. Warner Books, Inc., 748 F. Supp. 105, 108 (S.D.N.Y. 1990) (Walker, J.) (“[r]egardless of its critical reception in the literary world—and it is not for this court to pass on its literary merits—Walker’s book remains, without doubt, a work of criticism and scholarship”); see also New Era Publications Int’l, ApS v. Henry Holt & Co., 695 F. Supp. 1493, 1506 (S.D.N.Y. 1988) (Leval, J.) (“[i]t is an uncomfortable role for courts to serve as literary critics, passing on whether a purported work of history, teaching or criticism is entitled to respect as such. We judges generally lack both competence and the necessary information to form such opinions”), aff’d, 873 F.2d 576 (2d Cir. 1989), cert. denied, 110 S. Ct. 1168 (1990); infra text accompanying note 107 (quoting Judge Mansfield on aesthetics).
art critics, some of the distinctions copyright judges make necessarily lie close to those fields of endeavor. Indeed, courts regularly take account of published literary or art criticism of the works before them for various purposes when such criticism is consistent with their own judgments. When judges of the Second Circuit face distinctions based in part on aesthetic judgments, they sometimes seek to explain how their own aesthetic senses are involved and at other times retreat to an "I know it when I see it" position. On the whole, however, the circuit's jurisprudence appears to be moving toward articulation of decisions made at the intersection of law and aesthetics, as should be expected of the nation's leading copyright court.

I. FAIR USE

Fair use has been the most controversial copyright issue in recent Second Circuit jurisprudence, invoking both judicial and extrajudicial comment by members of the court.

Fair use is a privilege to use copyrighted material in a reasonable manner without consent, notwithstanding the copyright monopoly granted to the owner. It is not precisely defined in the law but is codified to an extent in section 107 of the Copyright Act, which is intended to set forth (but not list exhaustively) the judicially established principles of fair use. Fair use thus includes use for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research . . . . In determining whether the use made of a work in
any particular case is a fair use the factors to be considered shall include—

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes;

(2) the nature of the copyrighted work;

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.⁸

In addition, courts sometimes have considered other factors not enumerated in the statute, including any “bad faith” of the copyright user or, conversely, the extent to which a copyright violation is being asserted by an author in an attempt to suppress a work critical of him or herself.⁹

The Second Circuit has developed a well-articulated body of fair use jurisprudence covering most subjects.¹⁰ Among other things, the court historically has been relatively tolerant toward claims of fair use involving copying of portions of unpublished materials for use in nonfiction publications. A series of noted cases has considered the use of unpublished letters in biographies of Howard Hughes¹¹ and Julius and Ethel Rosenberg,¹² the reproduction of portions of the Zapruder film of President John F. Kennedy’s assassination,¹³ and The Nation’s unauthorized publication

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of parts of President Gerald R. Ford's autobiography—finding, in each instance, fair use. The string was broken in 1985, however, when the United States Supreme Court reversed the Second Circuit's decision in Harper & Row, Publishers, Inc. v. Nation Enterprises, involving President Ford's autobiography, stating in so doing that "the unpublished nature of a work is [a] key, though not necessarily determinative factor" in negating a fair use defense and that "the fact that a work is unpublished is a critical element of its 'nature.'" This reversal has led to a period of uncertainty in the Second Circuit in cases involving copying of unpublished materials such as letters or journals.

In Salinger v. Random House, Inc., the court upheld reclusive author J.D. Salinger's right to bar use of excerpts from more than forty of his unpublished letters in an unauthorized biography. The court referred to the Supreme Court's Harper & Row opinion, adding: "[W]e think that the tenor of the Court's entire discussion of unpublished works conveys the idea that such works normally enjoy complete protection against copying any protected expression."

In 1989-90, the court returned to the subject of use of unpublished works in a pair of cases involving quotations and paraphrasing of letters and other writings of Scientology founder L. Ron Hubbard in two critical biographies. In the first of these cases, New Era Publications International, ApS v. Henry Holt & Co. ("New Era I"), the court rejected a fair use justification for the biographer's copying of both published and unpublished material, but nevertheless affirmed the district court's denial of an injunction against publication of the book because the plaintiff had delayed in bringing the action. The majority opinion in New Era I also commented in strong terms on the copyright protection of unpublished materials against unauthorized quotation or close paraphrase:

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16 Id. at 554.
17 Id. at 564.
18 See Miner, supra note 1, at 8-11.
20 Id. at 97. Some of the letters were written to Judge Learned Hand. Id. at 92.
We made it clear in *Salinger* that unpublished works normally enjoy complete protection . . . . Where use is made of materials of an "unpublished nature," the second fair use factor [nature of the copyrighted work] has yet to be applied in favor of an infringer, and we do not do so here.22

After a period of public hue and cry about the likely restrictive effects of these decisions on the efforts of authors of biographic and historical works,23 and a substantial amount of commentary by judges concerning the logic underlying copyright policy aspects of various opinions,24 the court revisited fair use in *New Era Publications International, ApS v. Carol Publishing Group* ("New Era II").25 In that case, copying of documents in a book about Scientology and L. Ron Hubbard was held to be fair use. The court seemed to give particular weight to the critical nature of the biography (by a former Scientology follower whose views had changed) and held that a quotation of expressive material (which in this case had been published previously by Mr. Hubbard) had been fairly used to demonstrate facts about the writer's character.26

The chilling effect of the *Harper & Row* decision on judicial approval of fair use defenses for copying of unpublished works seems to have split the Second Circuit into two camps, at least insofar as analytical technique is concerned: one favors a relatively broad-brush approach, whereas the other looks to itemized dissec-

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22 Id. at 583.
23 See, e.g., Bilder, The Shrinking Book: The Law of Biography, 43 Stan. L. Rev. 299, 302-10, 321-23 (1991) (noting legal restrictions on activities of biographers and "brouhaha surrounding the judicial decisions and the congressional hearings"); Note, Remedies for Copyright Infringement: Respecting the First Amendment, 89 Colum. L. Rev. 1940, 1949-55 (1989) (discussing conflict between copyright and first amendment). The reaction to *Salinger* led to the introduction of proposed legislation which would have provided that fair use is to be determined in the same way for unpublished works as it is for published works, and members of the court submitted testimony on this bill. See supra note 1. The bill failed in the 101st Congress but has been reintroduced in a somewhat different form. The 1991 proposal (S. 1035) would add a sentence at the end of 17 U.S.C. § 107:

> The fact that a work is unpublished is an important element which tends to weigh against a finding of fair use, but shall not diminish the importance traditionally accorded to any other consideration under this section, and shall not bar a finding of fair use, if such finding is made upon full consideration of all of the above factors.

24 See supra note 1.
26 Id. at 157-58, 160-61.
tion of literary work. In order to temper what has been seen as the "complete" protection of unpublished material, members of both groups have pointed to a series of fact-expression distinctions that draw them into aesthetics. These fact-expression distinctions enable the court to reason, in appropriate cases, that the challenged use does not involve a core work of expression but, rather, material of a less expressive nature for which some flexibility may be allowed. The result is an increased scope for fair use.

Since facts themselves are not subject to copyright protection, courts traditionally have examined the material being copied to determine whether it is a statement of fact or expression. But further judgments about facts and expression can be made. First, a distinction may be found between works that are in their entirety "essentially factual in nature" or "primarily informational rather than creative." Second, even if the material is expressive, it may be subjected to fair use if the second author is using only statements of fact from the work, rather than what is regarded as the first author's expression. Third, even unpublished works may be subject to legitimate fair use by subsequent authors (although the law is not yet clear) if "copying is necessary fairly and accurately to report a fact set forth in the author's writings" or "primarily for informational purposes."

One commentator on Second Circuit fair use decisions has noted the court's oscillation between a "dissection approach"—which first excludes uncopyrightable ideas, facts, and cliché phrases before looking at the use of anything not so classified—and a "totality approach"—which characterizes all of the material copied as essentially expression (or not) before proceeding to apply the statutory fair use tests. In Harper & Row, Publishers, Inc. v. Nation Enterprises, the Second Circuit dissected the

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29 Id. (quoting Consumers Union of United States v. General Signal Corp., 724 F.2d 1044, 1049 (2d Cir. 1983), cert. denied, 469 U.S. 823 (1984)).
30 See, e.g., Salinger, 811 F.2d at 96.
copied work of President Ford and found key portions factual and unprotected; the Supreme Court looked at the totality of the work and disagreed. In *Salinger*, however, the Second Circuit rejected the district court’s dissection and instead viewed the copied work in its totality, finding the copyright infringed.

In its more recent cases, the Second Circuit has tended to follow the lead of *Harper & Row* in using the language of “totality”; but in doing so, it has gradually expanded the scope of what is sufficiently “factual” to allow wider scope for fair use. In *New Era I*, as in *Salinger*, the court’s majority again rejected the district court’s highly dissective approach, which had looked painstakingly at each passage used and had distinguished the use of expression to “enliven” a text from its use with “convincing justification” to illustrate an argument or in some other way truly necessary to achieve the biographer’s “point of significance.” The majority found that the district court’s analysis smacked too much of literary criticism (in which judges should not engage) and relied on a distinction that was “unnecessary and unwarranted.” After en banc consideration, four dissenting members of the court nevertheless expressed approval of dissection.

In *New Era II*, the Second Circuit adhered to the totality approach. The district court’s opinion constituted a somewhat different type of literary dissection, testing whether each bit of copied work was used “as a literary device rather than as a basis for critical study.” The Second Circuit’s opinion articulated more fully its preference for a nondissecting method of analysis and placed all of the copied material as a whole in a single category. The difference was that in this instance the work copied—which included some of Mr. Hubbard’s poetry—was termed entirely “factual or in-

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35 See id. at 202-09.
36 See *Harper & Row*, 471 U.S. at 569.
37 See *Salinger*, 811 F.2d at 97-98.
38 *New Era I*, 873 F.2d at 583.
39 Id.
41 *New Era II*, 904 F.2d at 155.
43 *New Era II*, 904 F.2d at 157.
The court wrote: "We have some hesitation in trying to characterize Hubbard's diverse body of writings as solely 'factual' or 'non-factual,' but on balance, we believe that the quoted works—which deal with Hubbard's life, his views on religion, human relations, the Church, etc.—are more properly viewed as factual or informational." The material, excerpts from published works, thus provided a generous scope for fair use.

The dissection/totality dichotomy reappeared in a decision by Judge Walker of the Second Circuit in Wright v. Warner Books, Inc. In that action, involving use of copyrighted unpublished letters in a biography of deceased novelist Richard Wright, Judge Walker took a dissection approach similar to that taken by the district judge and the Second Circuit dissenters in New Era I. The Wright court reviewed the copied material quotation by quotation to eliminate factual matter, and that which remained was found subject to fair use because it was "used more for primarily informational, rather than creative purposes." Although noting the Salinger rule that unpublished work "normally" enjoyed "complete" protection, Judge Walker held that Salinger still permitted a distinction between fact and expression. Because the material was used by the biographer "not to recreate Wright's creative expression, but simply to establish facts necessary to her biography," the fair use defense was upheld.

While the Court of Appeals for the Second Circuit does not yet seem to have elaborated a consistent approach toward the use of unpublished copyrighted works, its members have been creative in the use of both the totality and the dissection techniques to pro-

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" Id.

40 Id. A variation of the same theme occurs in a slightly earlier case, Maxtone-Graham v. Burtchaell, 803 F.2d 1253 (2d Cir. 1986), cert. denied, 481 U.S. 1059 (1987), involving copying of some 7,000 words from a book of essentially verbatim interviews with women who had chosen abortions or adoption written by an author commenting on the abortion issue from a social perspective antagonistic to the first author. The court recognized that the original work, K. MAXTONE-GRAHAM, PREGNANT BY MISTAKE (1973), was more than the product of "diligence" without expressive content, since it "like all interviews contains elements of creative journalistic effort." Maxtone-Graham, 803 F.2d at 1262. Still, the court found Pregnat by Mistake essentially factual in nature and on that basis accorded the subsequent author sufficient latitude to find fair use.


47 Id. at 111.

48 Id.

49 Id.
vide some flexibility for fair use. Under the former, a court may style all of the copied material as on the whole "factual or informational"; under the latter, even expressive copied material can be trimmed down to exclude the factual or clichéd, and then the residue may be described as used fairly to "establish facts" in the copyright user's work.

All three techniques require judgments about such matters as what is "informational" or "cliché," or what is a use of copied material to "establish facts" rather than "enliven" a biographer's prose. These issues all could be characterized as largely aesthetic. In effect, if the court determines that a use seems "fair" under all the circumstances, there is ample room to employ such techniques to fit within the rules laid down by the Supreme Court in *Harper & Row*. In their opinions, the judges of the Second Circuit seem uncomfortable with these aesthetic issues; but the result of recent cases seems to be a trend toward articulated fair use criteria and, in addition, a gradual return to reasonably generous interpretation of fair use after the unsettling effects of *Harper & Row*. The only book challenged and then enjoined in the Second Circuit in recent years, it should be remembered, was the Salinger biography. The basis for a finding of fair use of unpublished letters by a biographer may be hard to articulate, and some judges still balk at phrasing them in terms that might be seen as literary criticism. All the same, the court seems to be moving away from a broad-brush approach barring examination of nuance.

II. FACTUAL COMPILATIONS

The Second Circuit also has brought aesthetic judgments to bear on questions of copyright law involving factual compilations. The rules for determining the extent of protection for works such as telephone directories, case law reports, statistical collections, and—more recently—computer databases have provided fertile ground for litigation and scholarly comment.

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50 *See Salinger*, 811 F.2d at 100. The Salinger biography was published after two years of litigation, without the material found to be infringing.

51 *See*, e.g., Denicola, *Copyright in Collections of Facts: A Theory for Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516 passim (1981) (examining various approaches to factual compilations and suggesting express recognition of property interest in factual compilations to ensure unified approach); Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865 passim (1990) (discussing historical and contemporary protection of factual compilations, and sug-
As in the case of fair use, the Copyright Act provides only general guidance for factual compilations. The Act, like the United States Constitution, grants a limited monopoly for a term of years to an "author": a person who is the creator of a work entitled to copyright. The Act provides for, but fails fully to define, copyright of compilations of materials that themselves would be facts not subject to copyright. The Act defines compilations as works "formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." An "original work" thus is necessary; and because copyright protection is available only for expression and not for ideas or the facts and information that are contained in a compilation, mere "diligent collection" of unprotectable facts does not necessarily result in a compilation with any copyrightable content. As a consequence, "[c]opyright law and compilations are uneasy bedfellows."

Courts have grappled for decades with the extent to which a factual compilation must involve creativity. Some have found an element of creativity necessary, while others have relied on the "diligence" or "sweat of the brow" of the creators of factual

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63 Id. § 101.
64 Eckes v. Card Prices Update, 736 F.2d 859, 862 (2d Cir. 1984).
65 See, e.g., Harper House, Inc. v. Thomas Nelson, Inc., 889 F.2d 197, 201 n.2 (9th Cir. 1989) (court agreed with defendant's argument that amount of work expended by plaintiff did not resolve question of copyrightability); Miller v. Universal Cities Studios, 650 F.2d 1365, 1369-70 (5th Cir. 1981) (copyright rests "on the originality of the selection and arrangement of the factual material, rather than on the industriousness of the efforts to develop the information").
In 1991, the United States Supreme Court addressed this matter in *Feist Publications, Inc. v. Rural Telephone Service Co.*, a case involving telephone directories, holding that "originality, not 'sweat of the brow,' is the touchstone of copyright protection in directories and other fact-based works." The Court held that "choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original" to merit copyright protection. However, the Court also noted that "[t]here remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent" and that alphabetical arrangement of names with corresponding addresses and telephone numbers in a white page directory was "devoid of even the slightest trace of creativity." The Court explained that such arrangement "is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course."

In the Second Circuit, there has been no reluctance to take sides in this debate: an element of creativity is necessary, and, although the court did not venture to articulate a definition prior to the Supreme Court's decision in *Feist*, it appears to "know it when it sees it." The court stated its view on factual compilations in two 1984 cases, *Eckes v. Card Prices Update* and *Financial In-

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57 *Id.* at 1295.
58 *Id.* at 1289.
59 *Id.* at 1294.
60 *Id.* at 1296.
61 *Id.* at 1297.
63 Cf. *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring) ("I know it [hard-core pornography] when I see it, and the motion picture involved in this case is not that"). In an earlier era, the Second Circuit created what the United States Supreme Court in *Feist* characterized as "the classic formulation of the 'sweat of the brow' doctrine" in *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922), but repudiated it thereafter. See *Feist*, 111 S. Ct. at 1291; see also supra note 56 (examples of cases that have relied on "sweat of brow" doctrine).
64 736 F.2d 859 (2d Cir. 1984).
The first involved baseball cards: the author of a soft-covered book entitled “Sport Americana Baseball Card Price Guide” sued the publisher of a competing work entitled “Card Prices Update.” The plaintiff’s work was a comprehensive listing of some 18,000 baseball cards, with estimates of market values for each. The defendant’s product was a subsequent and more limited monthly “update” of prices for certain selected valuable cards—substantially those separately designated by plaintiff’s guide as “premium” cards. The trial court found the guide to card prices protectable by copyright and rejected defendant’s arguments that it had not copied plaintiff’s data. It nevertheless found that the prices quoted in the two publications were “not so substantially similar as to justify a finding of copyright infringement.”

The court of appeals agreed that the plaintiff’s selection of 5,000 cards as “premium” cards created a copyrightable compilation, and it found adequate evidence of infringement. Writing for the court, Judge Feinberg noted that subjective selection and arrangement of information may be protected, and then stated, without explanation, that there was “no doubt that appellants exercised selection, creativity and judgment in choosing among the 18,000 or so different baseball cards in order to determine which were the 5,000 premium cards.”

Moody’s Investors involved the “Financial Daily Called Bond Service,” which consisted of packets of four-inch by six-inch index cards mailed daily to subscribers and which reported on municipal and corporate bonds “called” (or redeemed) by their issuers. The information—consisting of such data as the name of the issuer of the bonds, the series of bonds being called, the date and price of redemption, and the name of the trustee or paying agent—was ob-

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66 Eckes, 736 F.2d at 860.
67 Id.
68 Id. at 861.
70 Id. at 464.
71 Eckes, 736 F.2d at 863.
72 Id.
tained principally from reading newspapers. This was no small effort because Financial Information Inc.'s employees were required to look through newspapers from all over the country and clip paid notices of calls placed locally by bond issuers. However, the court stated that "[t]here is apparently little, if any, editorial skill or creative discretion involved; the cards are essentially a compilation of financial facts collected from various sources, the key facts being those selected for publication." Financial Information sued Moody's Investors Service, Inc., which published similar data on called bonds in a different but "overlapping" format. Moody's presented evidence of its "independent creation" of its own data, which the trial court rejected. The district court also held the cards copyrightable, but upheld a fair use defense.

The Second Circuit, in an opinion by Judge Oakes, rejected the fair use defense. On remand, the district court found that the bond cards did not constitute a copyrightable compilation; and on a second appeal, the court of appeals agreed. Judge Lumbard noted, as had the Eckes court, the Second Circuit's "well-established reluctance to grant copyright protection to works of non-fiction—chiefly on the ground that facts may not be copyrighted." His opinion continued:

The statute thus requires that copyrightability not be determined by the amount of effort the author expends, but rather by the nature of the final result. To grant copyright protection based merely on the "sweat of the author's brow" would risk putting large areas of factual research material off limits and threaten the public's unrestrained access to information.

In applying these principles to the bond cards, the court deferred to the trial judge's factual determination that the plaintiff's

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74 Id.
75 Id.
76 Id.
77 Id. at 502-03.
78 Id. at 503.
79 Id. at 503-04.
80 Id. at 510.
82 Id. at 208.
83 Id. at 207.
84 Id.
work did not constitute an "independent creation." Indeed, the court noted, "The researchers had five facts to fill in on each card—nothing more and nothing less." Since the cards did not embody creativity, either individually or collectively, their compilation was not copyrightable.

In a pair of cases decided after *Feist*, the Second Circuit dealt further with the application of the "minimal degree of creativity" test articulated there. In *Kregos v. Associated Press*, the court held that a baseball pitching form distributed to newspapers by the plaintiff containing nine categories of data about past performances of the pitchers scheduled to start each game to be played that day may qualify for limited copyright protection with respect to the selection of particular categories of data, but not as to the arrangement of the categories on a form. The Second Circuit, in an opinion by Judge Newman, found that Kregos had selected the nine items of information concerning pitchers' performances from a universe of data containing many other items not selected, so that there was a factual question for trial as to the sufficiency of the creativity involved to avoid being, in the words of *Feist*, "entirely typical," "garden variety," or "obvious." However, the court agreed with the district court's conclusion that the arrangement of the selected statistics in a form was an "obvious" organization into columns analyzing each pitcher's performance for the season, against the day's opponent, and finally the pitcher's recent starts.

Two days later, in *Victor Lalli Enterprises v. Big Red Apple, Inc.*, the court affirmed a grant of summary judgment holding that charts published for use by gamblers who attempted to select daily "lucky numbers" that were derived from activity at local horse racing tracks lacked sufficient creativity to merit copyright protection. The court again emphasized that the data itself were not protected and held that the selection, coordination, and arrangement of the information failed to meet the "minimal creativity" test because the format of the cards was functional and en-

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86 Id. at 208.
87 Id.
88 937 F.2d 700 (2d Cir. 1991).
89 See id. at 704-05.
90 Id.
91 Id. at 709.
92 936 F.2d 671 (2d Cir. 1991).
93 Id. at 672-73.
tirely conventional, while the selection of data was devoid of creativity.\(^9\)

In the area of factual compilations, unlike fair use, the Second Circuit has been reluctant to articulate standards by which to judge what is sufficiently “creative,” but instead has retreated toward broad characterizations. The *Feist* decision similarly uses broad language of a conclusory sort. While the court’s rejection of a “sweat of the brow” justification for copyright was clearly stated and correctly anticipated the Supreme Court’s holding, the iota of creative contribution dividing merely “sweaty” works from “creative” ones is left either to judicial pronouncement as to what is “obvious” or, perhaps, to determinations by triers of fact. Determining what is “creative” and what is not seems necessarily to invoke aesthetic discrimination; but it is not clear at present in the Second Circuit how that function is to be performed.

### III. Utilitarian Design

A third copyright area in which judges are called upon to exercise aesthetic judgment involves the distinction between protectable “works of applied art” and “industrial designs,” which are not subject to copyright protection. The Copyright Act extends its protections to “pictorial, graphic, and sculptural works;”\(^9\) which may include a “useful article” under certain circumstances. Such an article, defined as one “having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information,”\(^5\) is considered a pictorial, graphic, or sculptural work under the Act “only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”\(^6\)

This requirement of “conceptual separability”—that an artistic element be distinguishable from the utilitarian function of the article—has caused various courts, including the Second Circuit, considerable concern about aesthetics and copyright law. In 1903, in a case involving the copyrightability of chromolithographs used

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\(^9\) *Id.* at 673-74.


\(^6\) *Id.* § 101.

on a circus poster, Justice Oliver Wendell Holmes announced what has come to be called the "antidiscrimination" principle, which dictates that judges should not inject their own aesthetic judgments into copyright decisions "outside of the narrowest and most obvious limits":

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.97

Judges of the Second Circuit have been careful, in their attempts to devise a test for conceptual separability, to state that they are as mindful as Justice Holmes of the need to avoid making aesthetic judgments—at least "outside of the narrowest and most obvious limits." In the first case to come before it raising the issue under the 1976 Act, Kieselstein-Cord v. Accessories by Pearl, Inc.98 the court (in an opinion by now Chief Judge Oakes) accepted the idea that copyrightability can be based on the "conceptual" separation of an artistic element (rather than on only physical separation) and held that ornamental belt buckles (which were sold to be worn but also were displayed in the Metropolitan Museum of Art) passed the test.99 The artist testified that he named one of the buckles "Winchester" because "he saw 'in [his] mind's eye a correlation between the art nouveau period and the butt of an antique Winchester rifle.'"100 Judge Oakes wrote that "[w]e see . . . conceptually separable sculptural elements, as apparently have the buckles' wearers who have used them as ornamentation for parts of the body other than the waist."101 Expert witnesses testified that "the buckles rise to the level of creative art."102

98 632 F.2d 989 (2d Cir. 1980).
99 Id. at 993-94.
100 Id. at 991.
101 Id. at 993.
102 Id. at 994.
District Judge Weinstein, sitting by designation, dissented, largely on the basis of legislative history. In his view, the Act calls for essentially physical separability: "the copyright protection covered only that aspect of the article that was a separately identifiable work of art independent of the useful article."\(^{103}\)

The second case, *Carol Barnhart Inc. v. Economy Cover Corp.*,\(^{104}\) involved the copyrightability of mannequins of partial human torsos used to display articles of clothing. A divided court held that they were not protected by copyright\(^{105}\) and in the process discussed at some length how aesthetic judgments might be brought to bear on the conceptual separability issue. Judge Mansfield, joined by Judge Meskill, called attention to Justice Holmes's "antidiscrimination" principle and also to legislative history affirming that copyright protection was not intended to extend to even the most "aesthetically satisfying and valuable" article of applied art or industrial design.\(^{106}\) In answer to the claim that the mannequins were examples of the traditional art of sculpture, Judge Mansfield wrote:

> We find no support in the statutory language or legislative history for the claim that merely because a utilitarian article falls within a traditional art form it is entitled to a lower level of scrutiny in determining its copyrightability. Recognition of such a claim would in any event conflict with the antidiscrimination principle Justice Holmes enunciated in *Bleistein v. Donaldson Lithographing Co.*\(^{107}\)

Without extended explanation, the court found that the mannequin features claimed to be aesthetic and artistic were "inextricably intertwined with the utilitarian feature, the display of clothes."\(^{108}\) Accordingly, there was no conceptual separability and no copyright protection.

In dissent, Judge Newman suggested a more detailed test for conceptual separability. First, however, he noted that the Copyright Act apparently vetoes what might be thought to be the most straightforward test: does the design of a form have "sufficient aes-

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\(^{103}\) Id. at 996.

\(^{104}\) 773 F.2d 411 (2d Cir. 1985).

\(^{105}\) Id. at 419.

\(^{106}\) Id. at 415-18; see also H.R. Rep. No. 1476, supra note 96, at 5668.

\(^{107}\) Carol Barnhart, 773 F.2d at 418 (citation omitted).

\(^{108}\) Id. at 419.
thetic appeal to be appreciated for its artistic qualities.”

The House Report, he wrote, clearly requires that the artistic features must be identified separately from function. According to Judge Newman, “the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function”—that is, the “mind’s eye” of the beholder must perceive “two different concepts that are not inevitably entertained simultaneously.” Copyrightability is present “if the concept of the utilitarian function can be displaced in the observer’s mind while he entertains the separate concept of some non-utilitarian function.” The beholder may be able to perceive, for example, an aesthetically pleasing chair “if the ordinary observer viewing it would entertain the concept of a work of art in addition to the concept of a chair.” Judge Newman also discussed the identity of the beholder in whose “mind’s eye” separability should be viewed: “I think the relevant beholder must be that most useful legal personage—the ordinary, reasonable observer. This is the same person the law enlists to decide other conceptual issues in copyright law, such as whether an allegedly infringing work bears a substantial similarity to a copyrighted work.”

The majority rejected Judge Newman’s reasonable man’s “mind’s eye” test of artistic separability as “a standard so ethereal as to amount to a ‘non-test’ that would be extremely difficult, if not impossible, to administer or apply.”

The court revisited the conceptual separability issue in Brandir International, Inc. v. Cascade Pacific Lumber Co., which involved a bicycle rack made of bent tubing said to have originated from a minimalist wire sculpture. Enlisting professorial commentators in the debate, Judge Oakes, writing for the court, noted scholarly endorsement for Judge Newman’s dissenting views in Carol Barnhart, but instead himself endorsed the analysis of another copyright scholar who had elaborated yet a differ-

\[109 \text{Id. at 422 (Newman, J., dissenting).} \\
110 \text{Id.} \\
111 \text{Id.} \\
112 \text{Id. at 423 (Newman, J., dissenting).} \\
113 \text{Id.} \\
114 \text{Id. at 422 (Newman, J., dissenting).} \\
115 \text{Id. at 419 n.5.} \\
116 834 F.2d 1142 (2d Cir. 1987). \\
117 Id. at 1147. \\
118 See W. Patry, Latman’s The Copyright Law 43-45 (6th ed. 1986).\]
ent test. The proper standard, Judge Oakes wrote, is whether "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." This "independent artistic judgment" test appears to focus on the circumstances and subjective intent of the designer. Judge Oakes wrote that it is consistent with the court's earlier case law because the artistic aspects of the belt buckles in Kieselstein-Cord "reflected purely aesthetic choices, independent of the buckles' function," while the mannequin torsos in Carol Barnhart "showed clearly the influence of functional concerns." Though the torsos bore artistic features," he wrote, "it was evident that the designer incorporated those features to further the usefulness of the torsos as mannequins." This test, the court predicted, would be relatively easy to administer in practice because "[t]he work itself will continue to give 'mute testimony' of its origins." In addition, evidence would be entertained concerning the "design process" of the work, "with the trier of fact making the determination whether the aesthetic design elements are significantly influenced by functional considerations."

Applying that test to the bicycle rack in question, the court noted that its creator claimed to have derived it directly from his sculptures as a separate idea, and that the sculptures had been conceived originally without any thought to utilitarian application. The opinion states that "[i]t seems clear that the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements." The court made its own comparison of the bicycle rack with the earlier sculptures and concluded that this comparison "reveals" that the rack was different from the sculptural inspiration in various ways and was "in its final form essentially a product of industrial design." The fact that the sculpture already existed before the possibility of adapting it for a functional use was conceived was critical. True to Jus-

119 Brandir, 834 F.2d at 1145 (citing Denicola, Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles, 67 MINN. L. REV. 707 (1983)).
120 Id. at 1145.
121 Id.
122 Id.
123 Id.
124 Id. at 1145-46.
125 Id. at 1146-47.
126 Id. at 1147.
tice Holmes's admonition, the court further noted that whether the bicycle rack would be considered good art was irrelevant. Rejecting Judge Newman's suggestion to ask whether an object such as the rack could "stimulate in the mind of the reasonable observer a concept separate from the bicycle rack concept," the court decided that the "harmonious fusion of function and aesthetics" that the rack represented doomed any hope of copyright protection.

Judge Winter dissented from the court's decision to adopt a test focussing on what he termed "the process or sequence followed by the particular designer," which "makes copyright protection depend upon largely fortuitous circumstances concerning the creation of the design in issue." As he noted, the bicycle rack easily could have been conceived before its sculptural inspirations had taken final form; the sequence was happenstance. Judge Winter endorsed Judge Newman's idea that "the relevant question is whether the design of a useful article, however intertwined with the article's utilitarian aspects, causes an ordinary reasonable observer to perceive an aesthetic concept not related to the article's use." In Judge Winter's view, which was consistent with the testimony of art experts at trial, any reasonable observer would find the bicycle rack in issue to be ornamental sculpture.

As the Second Circuit's case law in this copyright area now stands, therefore, judges listen to evidence about the process by which an article is designed and make a judgment regarding the "intertwining," or lack thereof, between function and aesthetics. Judges do not try to determine the ability of a reasonable observer's "mind's eye" to see a separate aesthetic aspect to a functional object.

In the area of utilitarian design, as with fair use, the court has attempted to articulate standards by which necessarily aesthetic

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127 Id.
128 Id. at 1151 (Winter, J., dissenting).
129 Id. at 1152 (Winter, J., dissenting).
130 Id. at 1151 (Winter, J., dissenting).
131 Id. at 1151-52 (Winter, J., dissenting).
132 The relationship between sculpture and a functional product has been raised subsequently, but the court decided the case without reaching this issue because the plaintiff had obtained the copyright registrations fraudulently. See Whimsicality, Inc. v. Rubie's Costumes Co., 891 F.2d 462, 466 (2d Cir. 1989); see also Goldberg & Bernstein, Of Nose Masks and Pumpkins: Protection of Costumes, 204 N.Y.L.J., Nov. 16, 1990, at 3, col. 1 (discussing principle of conceptual separability and evaluating its impact on copyright case law involving costumes).
judgments can be made. Unlike the Second Circuit law of factual compilations, these two areas show articulated efforts to advance beyond "I know it when I see it" jurisprudence. It seems fair to ask, however, whether the court is not unduly reluctant about accepting aesthetic judgments as the basis for distinctions in copyright law involving industrial designs or, indeed, across the board. The court's majority evidently accepts the need for judges to make distinctions regarding what is functional, as opposed to aesthetic, and it seems comfortable with judicial administration of a test that depends on rather subjective notions of "intertwining" of form and function. The result appears to be that judges still make essentially aesthetic judgments about functionality and sculptural works largely on the basis of "knowing it when they see it," while at the same time saluting Justice Holmes and proclaiming that they should not be seen as intruding into forbidden territory as art critics. The basis for decision would be more apparent if the court accepted the trier of fact's ability to decide separability on the basis of frank aesthetic judgment such as that proposed by Judges Newman and Winter.

CONCLUSION

Judge Learned Hand, an important contributor to Second Circuit copyright law, wrote that decisions on the question of copyrightability "must . . . inevitably be ad hoc." It seems equally inevitable that issues of aesthetic judgment, which are difficult to articulate, regularly will form part of the basis for these decisions. This should be no cause for alarm, so long as the judgments made are articulated—even at the risk of exposing the judges as sometime literary or art critics—and thus form a pattern of reasonable predictability.

133 Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960).